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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,017	07/13/2001	Fred T. Parker	PA-5262-RFB	2502

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COOK GROUP PATENT OFFICE  
P.O. BOX 2269  
BLOOMINGTON, IN 47402

EXAMINER

GHAFOORIAN, ROZ

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/905,017

Applicant(s)

PARKER ET AL.

Examiner

Roz Ghafoorian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 13 and 15-18 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

**Species A-figures 1-2**

**Species B- figure 3**

**Species C-figure 4**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no pending claim is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. -

2. During a telephone conversation with Mr. Agnew on 8-27-02 a provisional election was made with traverse to prosecute the invention of Species A, claims 1-12, 14, 19-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13, 15-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 14, 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 1 recites the limitation "its stressed" in line 8. There is insufficient antecedent basis for this limitation in the claim.
- b. Claim 2 recites the limitation "its stressed" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- c. Claim 19 recites the limitation "its stressed" in line 13. There is insufficient antecedent basis for this limitation in the claim.

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d. Claim 20 recites the limitation "it's stressed" in line 8. There is insufficient antecedent basis for this limitation in the claim.

e. Claim 21 recites the limitation "it's stressed" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 12, 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S Patent No.5462523 to Samson et al.

Samson teaches a medical device with a tube comprising a metal coil 126 in a stressed radially expanded condition, a metal braid 114, and a polymeric layer 108 positioned over and contacting the coil. The polymeric layer maintaining the coil in said stressed position. Furthermore, it teaches an inner lining 120 beneath and in contact with the coil (fig 4). The braid comprises of a plurality of crossed wires with a circular cross-section. And the diameter of the tube is 5-3mm.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 5462523 to Samson et al, and further in view of U.S Patent No. 6053903 to Samson.

As mentioned above Samson ('523) teaches a medical device with a tube comprising a metal coil 126 in a stressed radially expanded condition, a metal braid 114, and a polymeric layer 108 positioned over and contacting the coil. The polymeric layer maintaining the coil in said stressed position. Furthermore, it teaches an inner lining 120 beneath and in contact with the coil (fig 4). The braid comprises of a plurality of crossed wires with a circular cross-section. And the diameter of the tube is 5-3mm. However, Samson ('523) does not teach a polymeric layer made from nylon or polyurethane or PTFE, or a heat shrinking tube with thermally bonded coil. Samson ('903) teaches a medical device with a tube comprising of a polymeric layer made from nylon or PTFE and a heat shrinking tube with thermally bonded coils. (Col.9, lines 30-35)

Therefore, it would have been obvious to one having ordinary skill in the art the time the invention was made to have combined these two studies, because according to Samson ('903) this combination of material allows for a superior critical diameter and an integrated lubricous material without adding extraneous thickness and stiffness. (Col.7, lines 60-68)

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5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 5462523 to Samson et al and further in view of U.S Patent No. 5769830 to Parker.

As mentioned above Samson ('523) teaches a medical device with a tube comprising a metal coil 126 in a stressed radially expanded condition, a metal braid 114, and a polymeric layer 108 positioned over and contacting the coil. The polymeric layer maintaining the coil in said stressed position. Furthermore, it teaches an inner lining 120 beneath and in contact with the coil (fig 4). The braid comprises of a plurality of crossed wires with a circular cross-section. And the diameter of the tube is 5-3mm. However, Samson ('523) does not teach a polymeric layer with two segments with two durometers. Parker teaches a polymeric layer with two segments with two durometers.

Therefore, it would have been obvious to one having ordinary skill in the art the time the invention was made to have combined theses two studies, because according to Parker the two segmented durometers allows for a lubricous insertion segment for one durometers and strength and pushability for the other segment which allows the tube to be easily inserted to the patient without kinks.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Ghafoorian whose telephone number is 703-305-2336. The examiner can normally be reached on 8:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

RG

August 28, 2002



**BRIAN L. CASLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**